

Application No. 10/078,054  
Amendment dated December 19, 2003  
Reply to Office Action of October 2, 2003

### **REMARKS**

Applicant has amended claims 15 and 17. Claims 1-24 are now pending. No new matter has been introduced by any of the above amendments.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 112

The Examiner has rejected claims 15-17 under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention". Office Action, page 2, lines 5-7. Specifically, the Examiner asserts that in claims 15-21, the term "generally" is a "relative term that renders the claims indefinite" because the term "is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention". Office Action, page 2, lines 8-11. Applicant traverses.

Applicant respectfully submits that the term generally does not render the claims indefinite. Applicant further maintains that, in fact, the term "generally" did not limit the word "corresponding". This is so because the word "corresponding" does not require an exact match. For example, Merriam-Webster's Collegiate Dictionary, 10th edition (2001), includes in its definition of "correspond": "to be equivalent" and "to compare closely". Under the circumstances, in order to expedite prosecution of the present application, applicant has

amended claims 15 and 17 to remove the term "generally" on the understanding that, for practical purposes, the scope of the claim has not been changed by the amendment.

In addition, independent claims 15 and 17 have been amended to add the language "the lip liner is around the periphery of the lipstick core" at the final part of the claim. This amendment is not intended to modify the scope of the claim, but merely repeats what was already in the preamble of the claim and was already a limitation in each of claims 15 and 17 when the claims were properly construed.

#### CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected claims 1-14 and 22-24 under 35 U.S.C. § 102(b) as allegedly being anticipated by Kapustin, United States Patent No. 4,740,097 (hereinafter "Kapustin"). The Examiner contends that Kapustin teaches the following: (1) "a lipstick bullet that includes a lip liner, wherein the lip liner portion projects from the periphery of the exterior surface of the lipstick portion, thereby enabling two zones of lip cosmetics to be applied (Figure 1)"; (2) a lip liner portion "of an equilateral triangle shape, having sides about equal to 1/16 inch (col. 3, lines 47-57; col. 4, lines 3-9)"; (3) a lip liner which "may be of the same or different color from the lipstick portion (col. 4, lines 53-55)"; (4) "a lip liner lead that may have different properties, as well as featherproof properties which minimize the tendency of the lipstick to migrate (col. 4, lines 32-38)"; and (5) a lip liner that has "a surface area equal to 3 to 25% of the total cross-sectional surface area of the lipstick

bullet (Figure 3)". The Examiner alleges these teachings of Kapustin "meet the claims of the instant invention". Office Action, pages 2-3. Applicant traverses.

Firstly, Kapustin, as the Examiner points out, recites a lipstick bullet with a lip liner portion, which projects from a section of the exterior surface of the bullet (Figure 1), and which is shaped like an equilateral triangle, having sides about equal to 1/16 inch (col. 3, lines 47-57; col. 4, lines 3-9). Kapustin does not disclose a lip cosmetic comprising a lip liner composition surrounding the side exterior of the lipstick bullet.

In contrast to the lip cosmetic of Kapustin, the lip cosmetics called for by the claims of the present application comprise an elongated lipstick core and an outer layer of lip liner around the periphery of the elongated lipstick core (claims 1, 15 and 17 and page 3, lines 16-19; Figures 1, 3 and 7). Applicant specifically points out that a configuration in which the lipstick is surrounded by a lip liner composition, as in the instant invention, is distinct from and an improvement over the Kapustin configuration because the configuration of the instant application is more convenient to use. See, page 2, line 28 to page 3, line 7.

The reason why the claimed lip cosmetic is superior to the Kapustin lip cosmetic is that it is extremely difficult to apply the Kapustin lip cosmetic to the lower lip. Using a maneuver that is very awkward for the wrist, one has to turn the Kapustin lip cosmetic upside down and then hold it backwards to fit the slant of the lipstick to the lower lip. In contrast, the lipstick cosmetic of the present application is applied in a similar fashion as lipstick applications in the art. The configuration of the lip cosmetic of the present application also

allows for consistent performance over time. The tip of the Kapustin lip cosmetic, however, will change shape over time in such a way that usage will not be consistent over time.

Secondly, Kapustin does not teach a lip cosmetic comprising a lip liner composition having a higher melting point than the lipstick composition. Although, as the Examiner points out, Kapustin does recite that a lip liner lead "may possess different properties, including featherproof properties which restrains the migration of the lipstick" (col. 4, lines 33-38), the only properties recited in the specification and included in the claims are hardness and density. Kapustin teaches a lip liner which is normally more dense than the lipstick (col. 1, lines 55-58) and a liner which may have a higher hardness than the lipstick portion (col. 4, lines 32-33). In contrast, in the present invention, applicant clearly teaches and claims a lip liner composition that has a higher melting point than the lipstick composition. See, page 12, lines 8-12 and pending claims.

Thirdly, Kapustin also does not teach methods for making or using a lip cosmetic comprising an elongated lipstick core and an outer layer of lip liner. Nor does Kapustin teach such a method wherein the lip liner composition has a higher melting point than the lipstick composition. Conversely, the applicant teaches such methods throughout the specification in the present invention.

In sum, Kapustin does not teach a lip cosmetic comprising an elongated lipstick core and an outer layer of lip liner around the periphery of the elongated lipstick core. Nor does Kapustin teach a lip cosmetic comprising a lip liner composition having a higher melting

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point than the lipstick composition. Kapustin also fails to teach methods for making or using a lip cosmetic comprising an elongated lipstick core and an outer layer of lip liner wherein the liner has a higher melting point than the lipstick composition. Thus, Kapustin does not anticipate applicant's invention because Kapustin does not include every element of the applicant's claims.

#### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejects claims 1-14 and 22-24 under 35 U.S.C. § 103 as allegedly being unpatentable over Kapustin. The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kapustin, because Kapustin teaches a lipstick bullet which includes a lip liner, wherein the lip liner may be of the same color or of a different color from the lipstick portion". Office Action, page 4, lines 1-4. The Examiner also alleges that "Kapustin does not teach particular amounts", but "the particular amounts can readily be determined by one skilled in the art by routine experimentation". Office Action, page 3. Applicant traverses.

Applicant contends the instant invention is not obvious and unpatentable over Kapustin. As discussed above, Kapustin recites a lipstick bullet with a lip liner portion, which projects from a section of the exterior surface of the bullet, and which is shaped like an equilateral triangle (col. 3, lines 47-57; col. 4, lines 3-9). The lipstick bullets in Kapustin may be heart-shaped, tear-drop-shaped, oval, round, or any other shape "so long as there is a line of

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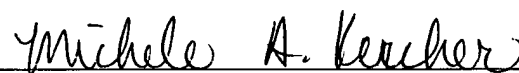
demarcation between lip liner lead and the lipstick portion of the lipstick bullet which extends between two points spaced apart on the periphery of the lipstick bullet so that upon transverse movement of the bullet there is little mixing of the lip liner and the lipstick mass as will be encountered during actual application of the lip liner and the lipstick" (col. 3, lines 47-57). In contrast, the present application recites a lip liner which surrounds the lip stick bullet, thereby making mixing of the liner and lipstick mass imminent upon transverse movement of the bullet. Thus, the user of the claimed lip cosmetic will simultaneously get both the benefits of the creamier feel and moisturizing function of the lipstick mass as well as the higher melting point properties of the lip liner.

Thus, Kapustin not only does not disclose a lip cosmetic comprising a lip liner composition surrounding the exterior of the lipstick bullet as discussed above, but also teaches away from such a lip cosmetic. This is a far cry from suggesting the claimed subject matter, which a reference must do to support a rejection for obviousness under the controlling authorities on obviousness.

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Applicant requests reconsideration of the above-identified application in view of the foregoing amendments and the above remarks.

Respectfully submitted,

A handwritten signature in cursive script, reading "Michele A. Kercher", is written over a horizontal line.

Richard M. Barnes (Reg. No. 27,277)

Attorney for Applicant

Michele A. Kercher (Reg. No. 51,869)

Agent for Applicant

FISH & NEAVE

Customer No. 1473

1251 Avenue of the Americas

New York, New York 10020-1104

Tel.: (212) 596-9000

Fax: (212) 596-9090